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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/467,646	12/20/1999	ANTHONY F. HERBST	NEWMRKTP99-4	2648

7590 05/20/2004  
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EXAMINER
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POINVIL, FRANTZY

ART UNIT	PAPER NUMBER
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3628

DATE MAILED: 05/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/467,646

Applicant(s)

HERBST ET AL.

Examiner

Frantzy Poinvil

Art Unit

3628

*mw*

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 02 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-51 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-51 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. Applicant's arguments are moot in view of the new grounds of rejection.

#### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 9-15, 20, 25-36 and 40-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rebane (US Patent No. 6,078,904).

As per claim 1, Rebane discloses a computer-aided method for operating a customizable investment fund. Rebane discloses receiving at a central computer, digital signals from a first computer specifying a custom set of investments for a fund; generating at the central computer digital signals for acquisition of investments consistent with the first digital signals and the second digital signals, entering transaction data at the central computer reflecting the acquisition of the investment and outputting a separate accounting for each set of investments within the fund. Applicant is directed to column 14, lines 27-55, and figures 2, 5 and 7 of Rebane. Rebane does not explicitly recite receiving a second digital signal from a second computer specifying a custom set of investments for the fund. Such would have been obvious to one of ordinary skill in the art because Rebane deals with a plurality of remote clients that may choose to invest or buy in one or more fund.

As per claims 9-10, checking for errors made in the specifying step and respectively testing the digital signals specifying a custom set of investments to ensure compliance with specifying rules would have been obvious to do in the system of Rebane in order to comply with the SEC and the clients main investment objective so as to avoid fines from the SEC or complaints from the clients.

As per claim 11, limiting composition of a set of investment and limiting a minimum amount of an investment is current practice when investing in a type of funds. Doing the same in Rebane would have been obvious to one of ordinary skill in the art so as to adhere to the normal practice of investing.

As per claim 12, subsets of the sets are similar to the amount, types of securities involved in the type of funds. Outputting an accounting for each subset would have been obvious to do in the system of Rebane so as to be informed how well certain stocks in a fund are performed, thereby figuring which stocks to sell or buy. See page 105 of Morris et al.

As per claim 13, specifying first client rules for the set of investments and storing the first client rules is taught on column 13, lines 45-67 of Rebane.

As per claim 14, changing the set of investments such that the fund is a dynamically ongoing fund is taught on column 13, lines 27-45 of Rebane and page 109 of Morris et al.

As per claim 15, note column 15, lines 20-53 of Rebane.

As per claim 20, Rebane teaches a cash management account for managing a client's investment. See column 11, lines 15-44 of Rebane.

As per claims 25-26, entering current market prices for investments to facilitate accounting is taught by Rebane. Note column 31, lines 24-45 of Rebane.

As per claim 27, the step of reallocating one of the investments from one set to another set at a current market prices and responsive to respective buy and sell signals is discussed in claim 27 of Rebane. Reallocating one of the investments from one set to another set at a current market prices and responsive to respective buy and sell signals from the first and second computers, wherein the reallocating does not include the bund buying or selling the one investment would have been obvious to one of ordinary skill in the art because other types of gains can be used to reallocate funds for one of the investments so as to maximize gains from a fund that is more profitable.

As per claims 28-29, 31, the accounting and the implementing are performed in real time.

As per claim 30, imposing a limit order is taught by Rebane. See column 10, line 65 to column 11, line 5 of Rebane.

As per claim 32, access of the system of Rebane can be via the Internet having related web pages. See column 9, lines 30-43.

As per claims 33-34 see column 9, lines 30-43 and column 10, lines 26-67 of Rebane.

As per claim 35, note figure 5, column 9, lines 30-55 and column 10, 25-54 of Rebane.

As per claim 36, note column 11, line 5 to column 12, line 39 and figure 5 of Rebane.

As per 40, note columns 11 and 12 of Rebane.

As per claim 41, access of the system of Rebane can be via the Internet having related web pages. See column 9, lines 30-43 of Rebane.

As per claim 42, claim 42, recites a client's demographic and financial profile in determining the best type of investment for the client or investor. Applicant is directed to column 4, lines 28-35 and column 6, lines 19-67 of Rebane.

As per claim 43, note column 5, line 16 to column 6, line 67, column 4, lines 28-35 and column 10, lines 27-36 of Rebane.

Art Unit: 3628

As per claim 44, column 11, line 45 to column 12, line 8 of Rebane.

4. Claims 2-8, 16-19, 21-24, 37-39 and 45-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rebane (US Patent No. 6,078,904) in view of Morris et al. ("Your Guide to Understanding Investing").

As per claims 2-8, interest-bearing assets, equity asset investments are not explicitly discussed by Rebane. Morris et al discuss various types of funds. See pages 98-115 of Morris et al. Generating digital signals for acquisition of equity asset investments, interest-bearing assets and derivatives would have been obvious to one of ordinary skill in the art at the time of the invention to do in the system of Rebane as taught by Morris et al because the objectives of a specific type of investment fund would have targeted the securities that the fund is being invested into.

As per claim 16, Rebane does not explicitly teach receiving at the central computer, digital signals from one of the first and second computers specifying automatic reinvesting of client income and client capital gains using the stored client rules. The Examiner notes that reinvesting of client income and client capital gains is usually done in an investment system. Such a limitation is taught by Morris et al on pages 101, 109 and 113. It would have been obvious to one of ordinary skill in the art at the time the invention was made to automatically reinvest client income as taught by Morris et al. in Rebane in order to maximize the potential profit for a client.

As per claim 17-19, client rules are taught by Rebane. Market conditions usually cause a fluctuation of prices of securities and funds. See page 110 of Morris et al. Rebane does not explicitly teach digital signals from one of the first and second computers specifying rebalancing using the stored client rules. Rebalancing an investment is well practiced in an investment plan or strategy. Such is usually done whenever a particular investment such as the purchasing or selling of a particular fund or securities does not bring expected returns. Thus, rebalancing using the stored client rules would have been obvious to do in the combination of Rebane and Morris et al. in order to maximize the profit returns of a client.

As per claims 21-23, Rebane discloses retrieving the stored first client rules in implementing the new transaction order with changed investments. Note column 13, lines 28-67 and column 15, lines 20-54 of Rebane. Reinvesting client income and client capital gains is taught by Morris et al. on pages 101, 109-110 and 113. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Morris et al. into Rebane in order to maximize the potential profit for a client.

As per claim 24, see the rejection of claim 18 above.

As per claims 37-39, connecting the central computer to a banking computer system in making a funds transfer or to an insurance company computer system in funding a variable annuity is not explicitly taught by Rebane and Morris et al. Doing so in the combination of Rebane and Morris et al. would have been obvious to one of ordinary skill in the art at the time



Art Unit: 3628

of the invention in order to facilitate access of information and access of funds to perform a transaction.

As per claim 45, see pages 100 and 104 of Morris et al.

As per claims 46-51, interest-bearing assets, equity asset investments are not explicitly discussed by Rebane. Morris et al. discusses various types of funds. See pages 98-115 of Morris et al. Generating digital signals for acquisition of equity asset investments, interest-bearing assets and derivatives would have been obvious to one of ordinary skill in the art at the time of the invention to do in the system of Rebane as taught by Morris et al because the objectives of a specific type of investment fund would have targeted the securities that the fund is being invested into.


### *Conclusion*

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frantzy Poinvil whose telephone number is (703) 305-9779. The examiner can normally be reached on Monday-Thursday 7:00AM-5:30PM.

The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9326 for Before Final actions and (703) 872-9327 for After Final actions.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

FP  
May 6, 2004

  
FRANTZY POINVIL  
PATENT EXAMINER  
A43628